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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ZURITA, JAMES H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/490,495

Applicant(s)

BLUMENAU, TREVOR

Examiner

James H Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 242-245, 247-255, 257-264, 266-275, 278-284, 286-291 and 313-316 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 242-245, 247-255, 257-264, 266-275, 278-284, 286-291 and 313-316 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 11/1/04
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2 July 2004 has been entered.

The Restriction Requirement of 15 October 2004 is hereby vacated. The present Office Action is a response to applicant's amendment of 2 July 2004 following a request for continued examination under 37 CFR 1.114.

Response to Amendment

Applicant filed an amendment on 2 July 2004, amending claims 242-244, 253-255, 263, 267-268, 275, 278-279, 284, 287, 290 and 291.

Applicant also cancelled claims 246, 256, 265, 276-277, 285 and added claims 313-316.

Claims 242-245, 247-255, 257-264, 266-275, 278-284, 286-291, 313-316 are pending and will be examined.

Response to Arguments

Applicant's arguments with respect to rejections under 35 USC 101 and 112 are persuasive and those rejections are withdrawn.

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Applicant's arguments with respect to claims 242-245, 247-255, 257-264, 266-275, 278-284, 286-291, 313-316 and prior art have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 242-245, 247-248, 250-255, 257-258, 260-264, 266-270, 272-275, 278-279, 281-284, 286-291, 313-316 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Dedrick (US 5724521).

For purposes of this examination, applicant's term **site** will be given its broadest reasonable interpretation as the spatial location of an actual or planned structure or site of structures. Prior art will be interpreted to read on site where prior art discloses nodes on a network, for example.

For purposes of this examination, applicant's term **content file** that include data such as images and executable instructions, is interpreted to read on objects.

As per Claims 242, 253, 263, 275, 287 and 313-316 Dedrick discloses networked nodes, systems and methods for detecting each time content is displayed at a content display site and generating monitoring information:

Content provider node(s) that store a content file. Dedrick discloses various types of content provider nodes, including Publisher, Clearinghouse server, Regional content server, yellow page server, advertiser. See at least Fig. 1 and related text. For storage of content files, please see references to content database 34, at least Col. 4, lines 3-15. The content files may contain embedded computer executable instructions. See, for example, references to objects, Col. 4, lines 49-58, Col. 12, line 66-Col. 13, line 28. Monitoring information includes information concerning display of content associated with the content file. See, for example, references to pay per view, viewing and searching of content by a user, at least Col. 13, lines 1-53.

Content display node(s) that receive content files from content provider sides. See, for example, references to client systems, at least Fig. 1 and related text. Clients may receive content files from content provider nodes and display content associated with the content file. See, for example, at least references to enabling users to view advertisements, at least Col. 13, lines 1-53. The client may execute monitoring instructions (embedded in objects) when the content is accessed, thereby generating monitoring information concerning display of content. See, for example, references to pay per view, at least Col. 13, lines 11-28.

Content display nodes may execute instructions to cause data (including monitoring information) to be transmitted to a remote node that did not supply the image. For example, clients communicate with metering servers, Col. 2, lines 60-67. A client's session manager software compiles statistical information and sends the information to the metering server. See, for example, at least Col. 6, lines 55-67.

Remote node(s) different from content provider node(s). See, for example, at least references to metering servers (item 14). These nodes are adapted to transmit data from content providers to content display nodes and to receive data signals and monitoring information from content display nodes. See at least references to client activity monitor, Col. 7, lines 1-15.

Please note that remote nodes do not provide content files (claim 263) and do not supply content file (claims 287, 313) since the content files originate from content providers.

As per claims 243, 254, 267, 278 and 290, Dedrick discloses that the at least one embedded instruction may comprise at least one instruction located in a content file. See, for example, references to objects, Col. 4, lines 49-58, Col. 12, line 66-Col. 13, line 28. Monitoring information includes information concerning display of content associated with the content file. See, for example, references to pay per view, viewing and searching of content by a user, at least Col. 13, lines 1-53.

As per claims 244, 255, 268, 279 and 291, Dedrick discloses that at least one embedded computer executable monitoring instruction (i.e., an object

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containing both data and executable code, at least Col. 4, lines 49-58, Col. 12, line 66-Col. 13, line 28) may comprises a link to (i.e., activates a pointer to or causes to execute identifiable and addressable computer instructions) at least one computer executable monitoring instruction that resides external to the content file (e.g., appraisal agent and activity monitor, resident on the content display site, at least Col. 4, lines 37-48, Col. 8, line 66-Col. 9, line 16, Col. 10, lines 45-63) and that causes generation of the monitoring information about the display of the content (Col. 7, lines 1-15).

As per claim 245, Dedrick discloses that generated monitoring information may indicate that content was displayed. See, for example, references to pay per view, viewing and searching of content by a user, at least Col. 13, lines 1-53. Monitoring information includes information concerning display of content associated with the content file.

As per claims 247, 248, 257, 258, 269, 270, 284, 286 Dedrick discloses

- **Extracting** encoded data from a data signal (claim 257, 269, 284). Please see references to transaction database at metering site. Encoded data in a data signal needs to be extracted before it can be classified and stored in a database for later access.
- **Storing** at the remote site generated monitoring information about a display of content (claim 247, 257, 284). See at least references to transaction database, Col. 11, lines 7-36.

- **analysis**¹ on generated monitoring information about the display of the content. (claims 248, 258, 270 and 286). See at least Col. 11, line 27-Col. 12, line 31, concerning metering and billing for services.

As per claims 250, 260, 272 and 281, Dedrick discloses that encoded data of a data signal may includes time stamps. See at least Col. 9, lines 28-48, concerning monitoring and reporting duration of a user's access of content.

As per claims 251, 261, 273 and 282, Dedrick discloses that generated monitoring information about display of content includes identifying information about the content display node. See at least Col. 7, lines 26-35.

As per claims 252, 262, 274 and 283, Dedrick discloses that generated information and encoded data of the data signal includes demographic information. See at least Col. 7, lines 1-36, Col. 9, lines 19-27, concerning demographic information stored in personal profile database that is sent to monitoring server.

As per claims 264, 288, Dedrick discloses that computer readable medium may be resident on a content provider node. Please see at least Col. 4, lines 16-36, Col. 7, lines 1-15, Col. 16, lines 31-50, concerning client activity monitor resident on client.

As per claims 266, 289, Dedrick discloses that computer readable medium may be resident on a content display node. Please see, for example, at least Col. 6, line 33-Col. 7, line 15.

¹ MS WORD Thesaurus: examine, study, investigate, evaluate, consider, explore, scrutinize, probe, dissect.

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As per claims 314-315, Dedrick discloses the use of HTML (hypertext markup language). See at least col. 4, lines 3-15.

As per claim 316, Dedrick discloses storing the content file at the content display site, wherein accessing the content file at the content display site comprises accessing the stored content file. See, for example, at least references to storing objects (content plus embedded executable instructions) with header information at a client, and later displaying and monitoring by activity monitor, at least in Col. 4, lines 49-58, Col. 7, lines 1-15.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 249, 259, 271 and 280 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick (US 5724521).

As per claims 249, 259, 271 and 280, Dedrick discloses that a content provider may have an account number (see, for example, at least Col. 14, lines 13-24). Dedrick discloses billing and the need for matching activity by end users with specific content providers and content files. See, for example, at least Col. 13, line 13-Col. 14, line 43.

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Dedrick **does not** specifically disclose that the content file is provided with the account number, and that the information generated by the display site contains the account number of the content provider.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a content provider account number and to provide a content file with the account number, and that the information generated by the display site contains the account number of the content provider. One of ordinary skill in the art at the time the invention was made would have been motivated to use a content provider account number and to provide a content file with the account number, and that the information generated by the display site contains the account number of the content provider for the obvious reason that having a common identifier for each transaction item may facilitate matching user actions with corresponding advertisements. This, in turn, facilitates billing and tracking user activity for any one particular advertisement or marketing campaign.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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22. Ury, Jill, Delahaye Group to Offer NetBench, Business Wire, New York, 31 May 1995, sec. 1, 3 pages.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JZ
James Zurita
Patent Examiner
Art Unit 3625
6 January 2005


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